The opinion in support of the remand being entered today was not written for publication and is not binding precedent of the Board.

Paper No.17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN PAUL BRENNAN and JAMES RALPH BRADFORD

Appeal No. 2004-0781
Application 09/654,444

ON BRIEF

Before RUGGIERO, DIXON, and LEVY, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this application is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

The rejection states (answer, page 3) that "[c]laims 1-10 and 12-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Culli et al." The examiner further states (answer, page 13) that:

> As to Appellant's argument regarding claims 7 and 18 discussed in section C of Appellant's appeal brief, see Examiner's above argument regarding claim 2.
> The issues regarding claim 18 are now moot because they are considered allowable by the examiner.

From this statement of the examiner, it is unclear as to whether the examiner is withdrawing the rejection of claim 18, or whether, because of the language "they are considered allowable" (underlining added) the examiner is withdrawing the rejection of claims 7 and 18. Also, if the examiner has withdrawn the rejection of claims 7 or 7 and 18, it is unclear as to why these claims are still listed in the rejection?

In addition, the examiner states (answer, pages 13 and 14) that:

> As to Appellant's argument regarding claims 8 to 19 discussed in section D of Appellant's appeal brief, see Examiner's above arguments regarding claims 2 and 7.
> Furthermore, see Col. 7, line 56-Col. 8, line 14, wherein it is discussed that the invention of Culli et al. contemplates various "customized calling plans," read as the claimed "extended dial plan," which "invoke" LRS on calls to other stations within the same Centrex." Because the language of Culli et al. reads that "customized calling plans" "invoke" certain actions this reads on the limitation in claims 8 and 19 that recite "when said terminating rate center is found in an originating rate center table of said originating rate center and an extended dial plan requirement indicated..." This is because claims 8 and 19 also recite that certain actions are taken as a result of finding an extended dial plan in the originating rate table, or in the terms used by Culli et al., customized calling plans found in the routing preferences of each

> switch, which is discussed above with regards to claim 2 and section B of Appellant's appeal brief. The issues regarding claim 19 are now moot because they are considered allowable by the examiner.

From the statement of the examiner, it is unclear as to whether the examiner is withdrawing the rejection of claim 19, or whether, because of the language "they are considered allowable" (underlining added) the examiner is withdrawing the rejection of claims 8 and 19. Additionally, if the examiner has withdrawn the rejection of claims 19 or 8 and 19, it is unclear as to why these claims are still listed in the rejection? Of note is that the examiner (id.) goes on to state "For the above reasons, it is believed that the rejections of claims 1-10 and 12-23 should be sustained."

From all of the above, it is unclear as to precisely which claims have been indicated as being allowable by the examiner, and which claims remain before us on appeal. It is also unclear as to why the examiner has listed claims (at least claims 18 and 19) as being rejected and also as being allowable. Moreover, we note that although appellants could have filed a reply brief to bring this matter to the attention of the examiner, they have chosen not to do so. Nevertheless, because it is unclear as to

which claims are before us on appeal, we find that remand of the application to the examiner for correction is appropriate.

SUMMARY

In light of the above, the examiner should carefully review the issues outlined, supra, and take appropriate action.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure (MPEP) § 708.01(D)(8th Ed., Rev. 2, May 2004). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal of this case.

REMANDED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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JOSEPH L. DIXON) BOARD OF APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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)
STUART S. LEVY)
Administrative Patent Judge)

SSL/gjh

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